

## **REMARKS**

### **I. Status of Claims**

Claims 22, 25, 28-33, 36-41, and 43-53 are pending in the application, with claims 22, 43, and 51 are independent. Claims 22, 25, and 29 are currently amended. Claims 43-51 are newly added. The Applicant believes no new matter is added. Claims 23-24, 26-27, 34-35, and 42 are canceled without prejudice to and/or disclaimer of the subject matter therein.

Claims 22-35, 39, and 42 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Samani (USP 5,645,599) ("Samani").

Claims 22 and 40-41 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Senegas (WIPO PUB WO01/28442).

Claims 36-38 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Samani.

The Applicant respectfully requests reconsideration of these rejections in view of the foregoing amendments and the following remarks.

### **II. Applicant's Statement of Substance of Examiner Interview**

In compliance with M.P.E.P. 713.04, the Applicant provides this Statement of Substance of Interview concerning the interview conducted May 19, 2009 between Examiner Fisher and Messrs. Ryu and Shanley.

- (A) Exhibits. N/A.
- (B) Claims. Claim 22.
- (C) Prior art. Samani and Senegas.
- (D) Amendments. Discussed proposed amendments to claim 22 and possibly adding method claims.
- (E) Principal arguments of Applicant. Samani and Senegas concern inter-spinous implants, but not an inter-laminae support/implant as recited in claim 22.
- (F) Other matters. N/A.
- (G) Results. Agreement was not reached regarding rejections. The Examiner indicated that much of the language of claim 22 was "intended use" language, thus, the Examiner did not afford this language patentable weight. The Examiner suggested a method claim and indicated that she would permit filing of the same in this application (i.e., without filing a divisional

application). Also Examiner Fisher and Mr. Shanley agreed to touch base following the filing of an RCE and response.

### **III. Pending Claims**

Assuming independent claims 22, 43, and 51 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Samani and Senegas.

The Applicant respectfully submits that claim 22 is patentable over the cited references at least because it recites an intervertebral support comprising, *inter alia*, "...an anterior portion, having a substantially planar face, suitable for being positioned in the space between the underlying and overlying laminae of two adjacent vertebrae, for restoring an anatomical intervertebral spacing..." and "...a posterior portion comprising a retaining member for preventing the support from migrating towards the anterior portion of the spine by pressing against the laminae, the posterior portion having a front portion and top and bottom faces, and the retaining member further comprises two transverse projections, one of which extends from a top face of the posterior portion, and the other of which extends from a bottom face of the posterior portion, and the planar face of the anterior portion having a smaller surface area than the front portion of the posterior portion...."

The Applicant respectfully submits that claim 43 is patentable over the cited references at least because it recites an intervertebral support comprising, *inter alia*, "...an anterior portion, having a substantially planar face, suitable for being positioned in the space between the underlying and overlying laminae of two adjacent vertebrae, for restoring an anatomical intervertebral spacing...", "...a posterior portion comprising a retaining member for preventing the support from migrating towards the anterior portion of the spine by pressing against the laminae...", and "...wherein the retaining member includes lateral shoulders set back from the anterior portion suitable for being received against the laminae of the vertebrae as close as possible to the articular facets...."

The Applicant respectfully submits that claim 51 is patentable over the cited references at least because it recites an intervertebral support comprising, *inter alia*, "...positioning the

anterior portion of the intervertebral support in a space between the underlying and overlying laminae of two adjacent vertebrae for restoring an anatomical intervertebral spacing...” and “...arranging the retaining member of the posterior portion of the intervertebral support so that it presses against the laminae to prevent the intervertebral support from migrating towards the anterior portion of the spine and for restoring three-dimensional mobility....”

Again, as pointed out in the previous response, the Applicant respectfully submits that an analysis of the Samani and Senegas reveals that both references concern an *inter-spinous* implant, but not *an inter-laminae* support/implant as required by the inventions of claims 22, 43, and 51. Therefore, as pointed out in the interview, it is respectfully submitted that the Office Action is misinterpreting the two cited references. That being said, the Applicant, without waiving any argument, and to advance prosecution, has amended claim 22 to further distinguish this claim from the cited references, as well as added claims 43 and 51, which also further distinguish certain embodiments of the present invention from the cited references.

The retaining members (reference numeral 6 of Samani and reference numerals 6a, 6b of Senegas) that are disclosed in the cited references do not equate to the retaining members of the inventions of claims 22 and 43 (which now specifically recite two transverse projections and lateral shoulders, respectively). Further, both claims 22 and 43 require that the anterior portion have a planar face (which is not shown in the cited references).

With that said, with respect to Samani, this reference describes an *inter-spinous* implant 5 having a “U” shape, a central portion 5a (that is flexible), and two branches 5b that comprise two pairs of brackets 6 adapted for receiving *spinous processes* 2 (See column 3, lines 38 to 65, and Figures 2 and 5, of Samani).

Regarding Senegas, this reference describes an *inter-spinous* implant having an “X” shape, a spacer 2—in which two opposite notches 6a-6b are formed—suitable for receiving the two respective *spinous processes* 26a-26b (See column 3, lines 1 to 10, and Figures 1 to 4, of Senegas).

Thus, the two implants described in Samani and Senegas are arranged to be positioned between two adjacent *spinous processes*, but not the inter laminae as with the support of the inventions of claims 22, 43, and 51 (claim 51 is a method claim).

Again, in contrast to Samani and Senegas, the supports of the inventions of claims 22, 43,

and 51 are arranged to be positioned between *two adjacent laminae*. Also, claim 51 is a method claim, and it is respectfully submitted that the Examiner must afford patentable weight to each and every limitation of the method claim (e.g., including the steps involving where the support is positioned). Further, these references neither describe the recited retaining members nor do their alleged anterior portions have planar surfaces.

Accordingly, the other cited references do not address the deficiencies of Samani and Senegas. As discussed in *KSR Int'l Co. v. Teleflex, et al.*, No. 04-1350, (U.S. Apr. 30, 2007), the Applicant respectfully submits that it remains necessary to identify the reason why a person of ordinary skill in the art would have been prompted to combine alleged prior art elements in the manner as claimed by the Applicant. Obviousness cannot be sustained on mere conclusory statements.

Accordingly, the Applicant respectfully submits that, for at least these reasons, claims 22, 43, and 51 and their dependent claims are patentable over the cited references.

#### **IV. Conclusion**

The Applicant respectfully submits that the present application is in all aspects in allowable condition, and earnestly solicits favorable reconsideration and early issuance of a Notice of Allowance.

The Examiner is invited to contact the undersigned at (202) 220-4420 to discuss any matter concerning this application. **The Office is authorized to charge any fees related to this communication to Deposit Account No. 11-0600.**

Dated: June 5, 2009

Respectfully submitted,  
By: /Daniel G. Shanley/  
Daniel G. Shanley  
Reg. No. 54,863

KENYON & KENYON LLP  
1500 K Street, N.W., Suite 700  
Washington, D.C. 20005  
202-220-4200 (phone)  
202-220-4201 (facsimile)  
Customer No. 23838